

REMARKS

The last Office Action has been carefully considered.

It is noted that claims 1-9, 12 and 13 are rejected under 35 U.S.C. 102(b) over the U.S. patent application publication to Ege, et al.

Claims 1-5, 7, 9, 12 and 13 are rejected under 35 U.S.C. 102(b) over the U.S. patent to Watanabe.

Claims 1, 2, 4, 5, and 7-13 are rejected under 35 U.S.C. 102(b) over the U.S. patent to Cuneo.

After carefully considering the Examiner's grounds for the rejection of the claims over the art, applicants have retained claim 1, the broadest claim on file as it was.

Some dependent claims have been amended, and new claims 14-18 have been added.

It is respectfully submitted that claim 1, the broadest claim on file, should be considered as patentably distinguishing over the art.

The Examiner indicated that in his opinion the patent documents applied by him disclose a dust container, which is integrated with a suction head. It should be emphasized that claim 1, to the contrary defines the suction device wherein a dust container is integrated in a suction head.

The patent application to Ege, et al discloses a dust removal unit (1) which includes a suction tube (4) running parallel to the axis (A) of the tool device (2) and coupled at one end to a suction head (3) (see abstract). Furthermore Ege et al describes that the suction head (3) is connected to a first end of said suction tube (4) (see page 2, claim 1). In addition Ege et al describes that a dust container (20) having an integrated bellows type filter (212) is downwardly removable (see page 2, paragraph 0024) from an outer part (13) being connected to the suction tube (4). The dust container (20) can be removed without taking away the suction head (3). Hence it is clear that the dust container (20) as described in Ege, et al is not integrated in the suction head (3) as defined in claim 1 of the application. Therefore the invention as defined in claim 1 is clearly novel over Ege, et al.

It is believed to be clear that the new features of the present invention which are now defined in claim 1 are not disclosed in the patent application publication to Ege, et al.

The patent to Watanabe, et al discloses a vacuum dust collecting device (22) for collecting dust from an area of an article being drilled by a drill bit (21) wherein a hose extending from a body of a hammer drill is directly connected to an end of a movable first pipe (29) which is slidably received in a stationary second pipe (30) (see abstract). The dust collecting device (22) includes a suction hood (27) slidably movable along the drill bit (21) and circumferentially covering the drill bit (21). The suction hood (27) has an elongate hollow wing (27b) for guiding the dust to said first pipe (29). The first pipe (29) is connected at one end to the wing (27b) (see col. 3, lines 55 to 67) and at the other end it is directly connected to one end of a flexible hose (31). The flexible hose (31) is connected with its second end to a dust collecting chamber (24). The dust collecting chamber (24) communicates with a discharge hole to which a dust bag (34) is connected for collecting the dust (see col. 4, lines 5 to 24). Hence it is clear that the dust bag (34) in Watanabe, et al is not integrated in the suction hood (27).

The patent to Watanabe also does not disclose the new features of the present invention as defined in claim 1.

The patent to Cuneo discloses a device (10) for sucking up material removed by a bit of a portable drill (see abstract). The suction device (10) comprises a duct (24) which is connected at a right angle to a suction head (26). Said suction head (26) consists of a lateral L-shaped end engaging with the

anterior end of the duct (24) to couple it through a passage (41) to a chamber (42) which is open at the front to form a suction inlet (44) (see col. 2, lines 59 to 64). Cuneo discloses no dust container which is integrated in the suction head (26), as recited in claim 1 of the invention.

The patent to Cuneo also does not teach the new features of the present invention as defined in claim 1.

With the integration of a dust container in the suction head a transport of dust over a short distance can be advantageously achieved. In all the suction devices described in the cited prior art the dust being collected by the suction head is transported over a substantial part of the suction device or over the whole suction device before this dust is captured in a dust container. In the devices of the cited prior art a deposit of dust in internal components of the suction device, as for example a deposit between the pleated bellow (6) and the spring (7) in Ege, et al causing abrasion, along the transport section cannot be avoided.

From the above presented analysis, it is believed to be clear that the new features of the present invention as defined in claim 1 are not disclosed in the references applied by the Examiner against the claims. The Examiner applied the references as anticipating the present invention. In connection with this it is believed to be advisable to cite the decision in re Lindenman

Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the references applied by the Examiner did not disclose each and every element of the present invention as now defined in claim 1 and therefore the anticipation rejection should be withdrawn for these reasons.

Also, as explained herein above, the present invention provides for the highly advantageous results which can not be accomplished by the devices disclosed in the references. It is well known that in order to support a valid rejection in the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals, in the case *Ex parte Tanaka, Marushma and Takahashi* (174 USPQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art to rewire prior art devices in order to accomplish applicant's result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

In view of the above presented remarks and amendments, it is believed that claim 1 should be considered as patentably distinguishing over the art and should be allowed.

The other claims depend on claim 1, they share its presumably allowable features, and therefore it is respectfully submitted that they should be allowed as well.

The Examiner's attention is also respectfully directed to the features of some dependent claims. Claim 4 defines the features which are disclosed in claim 7 and shown in Figures 1-4. Claim 14 defines the features which are disclosed on page 1, line 31, and on page 2, line 1. Claim 15 defines the feature which is disclosed in Figures 1-5.

Claim 16 defines the feature which can be derived from Figure 5. Claim 17 define the feature which is disclosed in Figures 1 and 2. Claim 18 defines the features which are disclosed in Figures 1 and 2 and in claim 4. Claim 19 defines the feature which is disclosed also in Figures 1 and 2. Claim 20 defines the features which can be derived from page 8, lines 6-14. Claim 21 defines the feature which can be derived from page 6, lines 21-27. Claim 22 defines the feature which is disclosed on page 7, line 5.

It is believed that the present application should be considered as allowable with all the claims currently on file.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

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